

AO 120 (Rev. 2/99)

<b>SOLICITOR</b> <b>SEP 18 2009</b> <b>U.S. PATENT &amp; TRADEMARK OFFICE</b> TO: Commissioner of Patents and Trademarks Washington, DC 20231	<b>REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
 filed in the U.S. District Court AT CINCINNATI on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. 1:09cv541	DATE FILED 7/31/09	U.S. DISTRICT COURT FOR THE SOUTHER DISTRICT OF OHIO, WESTERN DIVISION, CINTI OH
PLAINTIFF J.M. SMUCKER COMPANY		DEFENDANT SAN MARCO ROASTERS, INC., ET AL.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 SEE ATTACHED COPY	OF THE COMPLAINT	
2 6,861,086		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 SEE ATTACHED COPY	OF THE COMPLAINT	
2		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK JAMES BONINI	(BY) DEPUTY CLERK s/Scott M. Lang	DATE 9/1/09
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Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

**Count II**  
**Invalidity Of The '086 Patent**

41. Plaintiffs hereby refer to and incorporate by reference Paragraphs 1-40 above, as if fully set forth herein.

42. The claims of the '086 patent are invalid for failing to comply with one or more of the requirements for patentability set forth in Part II of Title 35 of the United States Code, including, but not limited to, §§ 101, 102, 103, and 112.

43. Plaintiffs are each entitled to a declaratory judgment that the claims of the '086 patent are invalid.

**PRAYER FOR RELIEF**

Plaintiffs respectfully pray for the following relief:

A. That the Court enter a declaratory judgment pursuant to 28 U.S.C. § 2201 that none of the Plaintiffs has infringed, and none is infringing, any claim of U.S. Patent No. 6,861,086, literally or by equivalents, directly or indirectly;

B. That the Court enter a declaratory judgment pursuant to 28 U.S.C. § 2201 that the claims of U.S. Patent No. 6,861,086 are invalid;

C. That the Court preliminarily and permanently enjoin Defendants from asserting infringement of U.S. Patent No. 6,861,086 against Plaintiffs;

D. That the Court adjudge and decree that this case is exceptional under 35 U.S.C. § 285 and award Plaintiffs their reasonable attorneys' fees, expenses and costs in this action; and

E. That this Court grant Plaintiffs such other and further relief that this Court deems just and proper.

**JURY TRIAL DEMAND**

Plaintiffs demand a trial by jury of all issues triable of right by jury.

Dated: July 31, 2009

Respectfully submitted,

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*The J.M. Smucker Company*

Dated: July 31, 2009

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*Attorneys for Plaintiff  
Kraft Foods Global, Inc.*

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF OHIO  
WESTERN DIVISION

THE J.M. SMUCKER COMPANY,	)	
THE FOLGERS COFFEE COMPANY,	)	
KRAFT FOODS GLOBAL, INC.,	)	
MELITTA USA, INC., AND	)	
EUROPEAN COFFEE CLASSICS, INC.,	)	Civil Action No. 1:09cv541
	)	
Plaintiffs,	)	Weber
	)	
vs.	)	<b>COMPLAINT</b>
	)	<b>AND JURY DEMAND</b>
	)	
SAN MARCO ROASTERS INC.,	)	
DOE COMPANY,	)	
BALSAM COFFEE SOLUTIONS INC.,	)	
ROBERT BUCKINGHAM,	)	
WILLEM ANKER,	)	
	)	
Defendants.	)	

Plaintiffs, The J.M. Smucker Company ("Smucker"), The Folgers Coffee Company ("Folgers"), Kraft Foods Global, Inc. ("Kraft"), Melitta USA, Inc. ("Melitta") and European Coffee Classics, Inc. ("ECC") (collectively, "Plaintiffs"), for their claims against Defendants San Marco Roasters Inc. ("San Marco"), Doe Company ("Doe"), Balsam Coffee Solutions Inc. (formerly known as 1361215 Ontario Inc.) ("Balsam"), Robert Buckingham ("Buckingham") and Willem Anker ("Anker") (collectively, "Defendants"), hereby state and allege the following:

**THE PARTIES AND PERSONAL JURISDICTION**

1. Smucker is a corporation organized and existing under the laws of the State of Ohio that maintains its principal place of business at One Strawberry Lane, Orrville, Ohio, 44667.

2. Folgers is a corporation organized and existing under the laws of the State of Delaware that maintains its principal place of business at 6210 Center Hill Road, Cincinnati, Ohio 45232. Folgers is a wholly-owned subsidiary of Smucker.

3. Kraft is a corporation organized and existing under the laws of the State of Delaware that maintains its principal place of business at Three Lakes Drive, Northfield, Illinois 60093.

4. Melitta USA, Inc. is a corporation organized and existing under the laws of the State of Florida that maintains a principal place of business at 13925 58<sup>th</sup> Street North, Clearwater, FL 33760.

5. ECC is a corporation related to Melitta USA organized and existing under the laws of the State of New Jersey that maintains its principal place of business at 1401 Berlin Rd., Cherry Hill, New Jersey.

6. On information and belief, San Marco is a corporation organized and existing under the laws of Canada that maintains its principal place of business at 1885 Clements Road, Pickering, Ontario, L1W 3V4 Canada or 141 Reach St., Uxbridge, Ontario L9P 1L3, Canada.

7. On information and belief, San Marco may be operating under a different name, which is currently unknown to Plaintiffs.

8. Defendant Doe is intended as a placeholder defendant until Plaintiffs can determine San Marco's current legal name.

9. On information and belief, Balsam is a corporation organized and existing under the laws of Canada that maintains its principal place of business at 6 Oakview Place, Uxbridge, Ontario, Canada L9P 1R4. On information and belief, Balsam was formerly known as 1361215 Ontario Inc.

10. On information and belief, Buckingham is a Canadian citizen having a principal residence at 6 Oakview Place, Uxbridge, Ontario, Canada L9P 1R4 or 11 Kilbride Drive, Whitby, Ontario, Canada L1R 2B2.

11. On information and belief, Anker is a Canadian citizen having a principal residence at 44 Balsam Street, Port Perry, Ontario, Canada L9L 1M6.

12. On information and belief and after a reasonable opportunity for further investigation and discovery, it is likely that Defendants San Marco, Doe, Balsam, Buckingham and Anker all conduct the same or similar business, share assets, places of business, locations, equipment, employees and expenditures, and act interchangeably and in disregard of their corporate and personal separateness such that Defendants San Marco, Doe, Balsam, Buckingham and Anker are the alter egos of each other.

13. This Court has personal jurisdiction over San Marco under subsection (A)(1) of the Ohio long-arm statute (O.R.C. § 2307.382) because San Marco has transacted business in this State and in this District. San Marco, through its president, agent, and alter ego, Buckingham, solicited business in Ohio by repeatedly offering to sell the patent-in-suit to Folgers and its previous parent company, The Procter & Gamble Company ("P&G") in Cincinnati, and by entering into a binding agreement with P&G's External Business Development ("EBD") group regarding the terms and conditions associated with Buckingham/San Marco's submission of the patent-in-suit to EBD for EBD's consideration.

14. On March 13, 2006, Buckingham, acting as president, agent and alter ego of San Marco, entered into a binding agreement with the EBD group. In the agreement, Buckingham agreed to be bound by several obligations regarding Buckingham's/San Marco's submission of the patent-in-suit for EBD's consideration, including obligations regarding Buckingham's and San Marco's future conduct relating to the patent-in-suit, and made several representations and warranties regarding the submission.

15. Beginning in March 2006, and continuing through October 2007, San Marco, through its president, agent and alter ego, Buckingham, solicited business in Ohio when he offered to sell the patent-in-suit to P&G and Folgers in Cincinnati for \$750,000, after entering into the binding agreement with EBD. Buckingham, as president, agent and alter ego of San Marco, made repeated inquiries to P&G in Cincinnati regarding his offer to sell the patent-in-suit to P&G and Folgers.

16. In early 2008, Buckingham and/or San Marco again approached P&G and Folgers through a broker, offering to sell the patent-in-suit.

17. By virtue of these dealings in the State of Ohio, and this District, San Marco is subject to the personal jurisdiction of this Court under O.R.C. § 2307.382(A)(1).

18. This Court has personal jurisdiction over Buckingham under subsection (A)(1) of the Ohio long-arm statute (O.R.C. § 2307.382) because of the agreement between EBD and Buckingham/San Marco regarding his submission of the patent-in-suit to EBD, as well as his repeated solicitations of business and related negotiations with Folgers and P&G in Cincinnati, attempting to sell Folgers and P&G the patent-in-suit.



19. This Court has personal jurisdiction over Balsam under subsection (A)(1) of the Ohio long-arm statute (O.R.C. § 2307.382) because San Marco and Buckingham are alter egos of Balsam, and their contacts with the State of Ohio and this District are imputed to Balsam.

20. This Court has personal jurisdiction over Anker under subsection (A)(1) of the Ohio long-arm statute (O.R.C. § 2307.382) because San Marco and Buckingham are alter egos of Anker, and their contacts with the State of Ohio and this District are imputed to Anker.

### **FACTUAL BACKGROUND**

21. Buckingham and Anker are the named inventors on United States Patent No. 6,861,086 entitled "Method of Processing Roasted Coffee" ("the '086 patent" or "the patent-in-suit") (Exhibit A).

22. The '086 patent is assigned on its face to 1361215 Ontario Inc. Buckingham and Anker assigned all right, title and interest in the patent application leading to the '086 patent to 1361215 Ontario Inc. on February 13, 2001. That assignment was recorded at the U.S. Patent and Trademark Office on February 14, 2001 at Reel 011564, Frame 0254. A copy of that assignment is attached as Exhibit B.

23. The '086 patent issued on March 1, 2005.

24. On June 9, 2005, 1361215 Ontario Inc., by its President Robert Buckingham, assigned all right, title and interest in the '086 patent to San Marco. That assignment was recorded at the U.S. Patent and Trademark Office on June 20, 2005 at Reel 016700, Frame 0426. A copy of that assignment is attached as Exhibit C.

25. Plaintiffs are not aware of any other assignments of the '086 patent.

26. On information and belief, San Marco currently owns all right, title and interest in the '086 patent.

27. On February 27, 2009, Balsam sued Plaintiffs in the Eastern District of Texas for alleged infringement of the '086 patent (hereinafter, "Texas Action").

28. At the time Balsam filed the complaint in the Texas Action, Balsam had no ownership interest in the '086 patent because it had assigned all right, title and interest in the '086 patent to San Marco on June 9, 2005. As a result, Balsam lacked standing to bring the Texas Action, depriving the Texas court of subject matter jurisdiction over the Texas Action, *ab initio*.

29. Plaintiffs jointly moved to dismiss the Texas Action for lack of subject matter jurisdiction on July 31, 2009.

**COUNTS I AND II**  
**DECLARATORY JUDGMENT OF**  
**NON-INFRINGEMENT AND INVALIDITY**

**Jurisdiction and Venue**

30. Plaintiffs refer to and incorporate by reference Paragraphs 1-29 above, as if fully set forth herein.

31. This action arises under the patent laws of the United States, 35 U.S.C. § 1, *et seq.*

32. Venue is proper in this District under 28 U.S.C. § 1391(b)(2), 1391(d) and 1400(b).

33. By virtue of filing the Texas Action accusing Plaintiffs of infringement of the '086 patent, Balsam, San Marco, Buckingham and Anker have caused Plaintiffs to have a reasonable apprehension of being sued for infringement of the '086 patent.

34. An actual and justiciable controversy exists between Plaintiffs and Defendants concerning the non-infringement and invalidity of the '086 patent by virtue of Defendants' allegation of infringement against Plaintiffs in the Texas Action. Accordingly, subject matter

jurisdiction for this declaratory action is proper in this Court under 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

**Count I**  
**Non-Infringement Of The '086 Patent**

35. Plaintiffs hereby refer to and incorporate by reference Paragraphs 1-34 above, as if fully set forth herein.

36. Plaintiffs have operated coffee manufacturing processes that Defendants allege infringe the '086 patent.

37. Plaintiffs continue to operate coffee manufacturing processes that Defendants allege infringe the '086 patent.

38. None of the Plaintiffs has directly or indirectly infringed, induced infringement of, or contributed to the infringement of any valid claim (or claims) of the '086 patent under 35 U.S.C. § 271.

39. Defendants are estopped from construing the claims of the '086 patent to cover or include, either literally or by application of the doctrine of equivalents, products manufactured, used, imported, sold, or offered for sale by each Plaintiff or methods used by each Plaintiff, because of admissions and statements to the U.S. Patent and Trademark Office during prosecution of the application leading to the issuance of the '086 patent, and because of disclosures or language in the specification of the '086 patent and/or limitations in the claims of the '086 patent.

40. Plaintiffs are each entitled to a declaratory judgment that they each have not infringed, and are not infringing any valid claim of the '086 patent, literally or by equivalents, directly or indirectly.